

III. REMARKS

Reconsideration of this application in light of the above amendments and the following remarks is requested.

Independent claims 1, 3, 18, and 19 have been amended to add the limitations of claims 11, 5, 21, and 33 respectively.

Claims 5, 6, 8, 11, 20, 21, and 33-45 are cancelled

Dependent claims 2, 4, 7, 9, 10, 12, 13-17, and 22-32, which depend from one of the independent claims 1, 3, 18, 18 and 19 have been maintained in their previous form.

Some of the previously presented claims were rejected under 35 U.S.C. §103(a) as being unpatentable over Hultgren in view of Musa. However, this rejection is not applicable to amended claim 1 for the following reasons.

As the PTO recognizes in MPEP §2142:

The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.

The examiner clearly cannot establish a prima facie case of obviousness in connection with amended claim 1 since 35 U.S.C. §103(a) provides that:

[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, Hultgren and Musa, alone, or in combination, do not teach a method of effecting a cashless payment transaction by means of a merchant station characterized by a merchant station identification code, a mobile cell phone with a SIM card characterized by an identification code identifying the SIM card, and a comparing device, which comprises a transaction data memory device, a merchant checking device for checking the identification codes of the merchant stations authorized for this method, and a subscriber checking device for

checking the identification codes of the SIM cards authorized for this method and which is connected to account keeping device, comprising the steps:
reading an amount of money to be paid into the merchant station, transmitting, by the merchant station, the identification code of the merchant station and at least the amount of money to the comparing device through a data link, checking the authority of the merchant station for the method, using the merchant checking device, terminating the method in the absence of the authority, otherwise writing the data as an open transaction into the transaction memory device of the comparing device, after the step of reading the amount of money into the merchant station, making a connection from the mobile cell phone to the comparing device, transmitting the identification code of the merchant station and the identification code associated with the SIM card from the mobile cell phone to the comparing device, checking the authority of the SIM card for the method, using the subscriber checking device, in the absence of the authority terminating the method, clearing the open transaction from the transaction memory and the transmitting corresponding data to the merchant station, otherwise comparing the merchant station identification code transmitted from the mobile cell phone with those of the open transactions stored in the transaction memory device and on failure to find such a transaction terminating the process and, on finding the transaction, transmitting the transaction data to the mobile cell phone, outputting the data through the mobile cell phone, requesting confirmation information through the mobile cell phone, transmitting the confirmation data to the comparing device, terminating the transaction and clearing the transaction from the transaction memory if the confirmation data corresponds to a refusal, and transmitting the transaction data from the transaction memory and the identification code of the mobile cell phone to an account keeping device and clearing the transaction from the transaction memory in the alternative case; and transmitting additional supplementary transaction data to the comparing device or mobile cell phone from the merchant station.

Therefore, it is impossible to render the subject matter of claim 1 as a whole obvious based on any combination of the patents, and the above explicit terms of the statute cannot be met. As a result, the examiner's burden of factually supporting a prima facie case of obviousness clearly cannot be met with respect to claim 1, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why the Hultgren and Musa patents cannot be combined and applied to reject claim 1 under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he examiner must step backward in time and into the shoes worn by the hypothetical “person of ordinary skill in the art” when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention “as a whole” would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Here, Hultgren and Musa do not teach, or even suggest, the desirability of the combination set forth above since neither teaches or suggests providing the combination.

Thus, neither of these patents provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of claim 1.

In this context, the MPEP further provides at §2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.
(emphasis in original)

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the examiner’s combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 1. Therefore, for this mutually exclusive reason, the examiner’s burden of factually supporting a prima facie case of obviousness clearly cannot be met with respect to claim 1, and the rejection under 35 U.S.C. §103(a) is not applicable.

The rejection under 35 U.S.C. §103(a) based on Hultgren in view of Musa is not applicable to amended claim 3 for the following reasons.

As the PTO recognizes in MPEP §2142:

The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.

The examiner clearly cannot establish a prima facie case of obviousness in connection with amended claim 3 since 35 U.S.C. §103(a) provides that:

[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, Hultgren and Musa, alone, or in combination, do not teach a method of effecting a cashless payment transaction by means of a merchant station characterized by a merchant station identification code, a mobile cell phone with a SIM card and an identification code associated with the SIM card and a comparing device, which comprises a transaction memory device, a merchant checking device for checking the identification codes of the merchant stations authorized for this method, and a subscriber checking device for checking the identification codes of the SIM cards authorized for this method and, in the case in which the identification code of the SIM card is not its telephone number, for storing the telephone numbers associated with the SIM cards, and which is connected to account keeping devices, comprising the steps of reading into the merchant station the amount of money to be paid and the identification code of a SIM card of a mobile cell phone, transmitting, by the merchant station, the identification code of the merchant station, the identification code of the mobile cell phone and at least the amount of money to the comparing device over a data link, checking the authority of the merchant station for the method by comparison with the entries in the merchant checking device, checking the authority of the SIM card for the method using the subscriber checking device, terminating the method in the absence of authority, otherwise writing the data as an open transaction into the transaction memory device, in the case in which the identification code of the SIM card is not the telephone number, reading the telephone number out of the subscriber checking device on the basis of the identification code, making a connection from the comparing device to the mobile cell phone using the telephone number obtained, transmitting the transaction data to the mobile cell phone, outputting the data by the mobile cell phone, requesting confirmation information through the mobile cell phone, transmitting the confirmation data to the

comparing device, terminating the transaction if the confirmation data corresponds to a refusal, transmitting the confirmation and optionally further transaction data to the merchant station, transmitting the transaction data from the transaction memory and the identification code of the mobile cell phone to an account keeping device and clearing the transaction from the transaction memory; and terminating the transaction if the confirmation information is not given within a predetermined time after transmitting the information from the merchant station to the comparing device.

Therefore, it is impossible to render the subject matter of claim 3 as a whole obvious based on any combination of the patents, and the above explicit terms of the statute cannot be met. As a result, the examiner's burden of factually supporting a prima facie case of obviousness clearly cannot be met with respect to claim 3, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why the Hultgren and Musa patents cannot be combined and applied to reject claim 3 under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Here, Hultgren and Musa do not teach, or even suggest, the desirability of the combination set forth above since neither teaches or suggests providing the combination.

Thus, neither of these patents provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of claim 3.

In this context, the MPEP further provides at §2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (emphasis in original)

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 3. Therefore, for this mutually exclusive reason, the examiner's burden of factually supporting a prima facie case of obviousness clearly cannot be met with respect to claim 3, and the rejection under 35 U.S.C. §103(a) is not applicable.

The rejection under 35 U.S.C. §103(a) based on Hultgren in view of Musa is not applicable to amended claim 18 for the following reasons.

As the PTO recognizes in MPEP §2142:

The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.

The examiner clearly cannot establish a prima facie case of obviousness in connection with amended claim 18 since 35 U.S.C. §103(a) provides that:

[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, Hultgren and Musa, alone, or in combination, do not teach a merchant station characterized by a merchant station identification code, a mobile cell phone with a SIM card and an identification code characterizing the SIM card, a comparing device, which comprises a transaction data memory device, a merchant checking device for checking the identification codes of the merchant stations authorized for this method and a subscriber checking device for checking the identification codes of the SIM cards authorized for this method and which is connected to account keeping devices, wherein the comparing device comprises: a subscriber checking device in which is held the identification code of each mobile cell phone and the account number associated therewith in the account keeping device, and a control device

for transmitting to the account keeping device the account number corresponding to the identification code, on the basis of the information in the subscriber checking device, rather than the identification code of the mobile cell phone, the merchant station comprising an input device and an output device and a device for making a data connection to the comparing device, the comparing device further comprises interface devices for data connection to merchant stations, interface devices for mobile cell phone connections, as well as control devices, which after the merchant station makes a connection to the comparing device and transmits transaction data from a merchant station to the comparing device, checks the authorization of the merchant station for the method, using the merchant checking device and terminates the method in the absence of authorization but otherwise enters the transmitted transaction data in the transaction data memory device, on making a connection from a mobile cell phone receives the identification code of the SIM card, checks the authorization of the SIM card for the method using the subscriber checking device, and terminates the method in the absence of authorization, but otherwise compares the identification code of the merchant station with the entries in the transaction data memory device and, on finding a transaction with the same merchant station identification code, transmits the located transaction data to the mobile cell phone through the interface device for mobile cell phone connections and also sends a request for confirmation thereto, and receives the confirmation data through the interface device for mobile cell phone connections, interprets this as acceptance or refusal, transmits the confirmation information through the interface device to the merchant station and in the case of acceptance transmits the transaction data and the identification code of the mobile cell phone to the account keeping device.

Therefore, it is impossible to render the subject matter of claim 18 as a whole obvious based on any combination of the patents, and the above explicit terms of the statute cannot be met. As a result, the examiner's burden of factually supporting a prima facie case of obviousness clearly cannot be met with respect to claim 18, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why the Hultgren and Musa patents cannot be combined and applied to reject claim 18 under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he examiner must step backward in time and into the shoes worn by the hypothetical “person of ordinary skill in the art” when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention “as a whole” would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Here, Hultgren and Musa do not teach, or even suggest, the desirability of the combination set forth above since neither teaches or suggests providing the combination set forth above.

Thus, neither of these patents provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of claim 18.

In this context, the MPEP further provides at §2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (emphasis in original)

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the examiner’s combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 18. Therefore, for this mutually exclusive reason, the examiner’s burden of factually supporting a prima facie case of obviousness clearly cannot be met with respect to claim 18, and the rejection under 35 U.S.C. §103(a) is not applicable.

The rejection under 35 U.S.C. §103(a) based on Hultgren in view of Musa is not applicable to amended claim 19 for the following reasons.

As the PTO recognizes in MPEP §2142:

The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.

The examiner clearly cannot establish a prima facie case of obviousness in connection with amended claim 19 since 35 U.S.C. §103(a) provides that:

[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, Hultgren and Musa, alone, or in combination, do not teach a merchant station with a merchant station identification code, a mobile cell phone with a SIM card and an identification code characterizing the SIM card, and a comparing device comprising a transaction data memory device, a merchant checking device for checking the identification codes of the merchant stations authorized for this method and a subscriber checking device for checking the identification codes of the SIM cards authorized for this method, and if the identification code is not the telephone number, storing the telephone number, and which is connected to account keeping devices, wherein the merchant station comprises an input device and an output device and a device for making a data connection to the comparing device, the comparing device further comprising interface devices for data connection to the merchant station, interface devices for mobile cell phone connections, as well as control devices, which after the merchant station makes a connection to the comparing device and transmits transaction data from a merchant station to the comparing device, checks the authorization of the merchant station for the method, using the merchant checking device, and the authorization of the SIM card for the method, using the subscriber checking device, and terminates the method in the absence of authorization, but otherwise enters the transmitted transaction data in the transaction data memory device, makes a connection through the interface device for mobile cell phone connections, corresponding to the identification code for the mobile cell phone contained in the transaction data, transmits the transaction data to the mobile cell phone and sends a request for confirmation to this, and receives the confirmation data through the interface device for mobile cell phone connections, interprets it as an acceptance or a refusal, in the case of acceptance transmits the confirmation information to the merchant station through the interface device and transmits the transaction data and the identification code of the mobile cell phone to the account keeping device, and a merchant checking device in which is held the identification code of each merchant station and the account number associated therewith in the account keeping device,

wherein the control device transmits to the account keeping device the account number corresponding to the identification code, on the basis of the information in the merchant memory device, rather than the identification code of the merchant station.

Therefore, it is impossible to render the subject matter of claim 19 as a whole obvious based on any combination of the patents, and the above explicit terms of the statute cannot be met. As a result, the examiner's burden of factually supporting a prima facie case of obviousness clearly cannot be met with respect to claim 19, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why the Hultgren and Musa patents cannot be combined and applied to reject claim 19 under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Here, Hultgren and Musa do not teach, or even suggest, the desirability of the combination set forth above since neither teaches or suggests providing the combination.

Thus, neither of these patents provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of claim 19.

In this context, the MPEP further provides at §2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (emphasis in original)

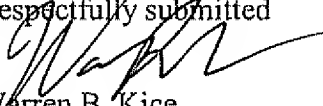
In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to

claim 19. Therefore, for this mutually exclusive reason, the examiner's burden of factually supporting a prima facie case of obviousness clearly cannot be met with respect to claim 19, and the rejection under 35 U.S.C. §103(a) is not applicable.

It is thus clear from the foregoing that independent claims 1, 3, 18, and 19 are allowable.

Dependent claims 2, 4, 7, 9, 10, 12, 13-17, and 22-32, depend from one of the independent claims 1, 3, 18, 18 and 19, and are therefore also in condition for allowance.

Respectfully submitted


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